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OFFICE OF PETITIONS

In re Patent No. 7,084,260 : LETTER REGARDING
Lonberg et al. : PATENT TERM ADJUSTMENT
Issue Date: August 1, 2006 : and
Application No. 08/728,463 : NOTICE OF INTENT TO ISSUE
Filed: October 10, 1996 : CERTIFICATE OF CORRECTION
Atty Docket No. 14643-009020 :

This is in response to the "REQUEST FOR CERTIFICATE OF CORRECTION PURSUANT TO 37 CFR 1.322" filed October 2, 2006, notifying the Office of an error in Patentees' favor in the determination of patent term adjustment under 35 U.S.C. § 154(b)¹ indicated on the above-identified patent. Patentees disclose that the patent term adjustment indicated on the patent should be five hundred fifty-one (551), not six hundred three (603) days. This request was recently forwarded to the undersigned for consideration.

This paper should have properly been filed as a Letter Regarding Patent Term Adjustment, pursuant to Comment 43. See *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000). There is no fee for such a letter notifying the Office of an error in applicants/patentees favor.

The request for correction of the determination of patent term adjustment (PTA) is **GRANTED to the extent indicated herein.**

¹ This application became eligible for patent term adjustment for examination delay by virtue of the filing of a continued prosecution application on July 17, 2000.

Patentees are given **TWO (2) MONTHS** from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **FOUR HUNDRED EIGHTY-SEVEN (487)** days.

On August 1, 2006, the application matured into U.S. Patent No. 7,084,260, with a revised patent term adjustment of 603 days. On October 2, 2006, patentees submitted this request for reconsideration of patent term adjustment, asserting that the correct number of days of Patent Term Adjustment is 551 days. Patentees state no basis for their assertion that the patent term adjustment should be 551 days.

Nonetheless, a review of the application history reveals that additional periods of reduction pursuant to 37 CFR 1.704(c)(7) and (c)(10) should have been entered. Pursuant to § 1.704(c)(7), a period of reduction of 52 days should have been entered. 37 C.F.R. § 1.704(c)(7) provides that a period of reduction is entered for:

Submission of a reply having an omission (§ 1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed.

In this instance, a response was filed on March 16, 2001. However, by Notice to Comply with Sequence Rules mailed April 10, 2001, applicants were advised that there was an omission in their response. On May 7, 2001, applicants filed a response correcting the omission. Thus, the period of reduction is 52 days counting the number of days in the period beginning on March 17, 2001, the day after the first response was filed, and ending on May 7, 2001, the date that the response correcting the omission was filed.

Furthermore, a review of the record reveals that a period of reduction, pursuant to 37 CFR 1.704(c)(10), of 64 days should have been entered in association with the filing of a REQUEST FOR ACKNOWLEDGMENT OF PREVIOUSLY SUBMITTED INFORMATION

DISCLOSURE STATEMENT filed October 28, 2005 (and resubmitted December 19, 2005). 37 CFR 1.704(c) provides, in pertinent part, that:

Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(10) Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or

(ii) Four months; ...

This request was filed after the mailing of the Notice of Allowance. This request was for acknowledgment of references last submitted to the Office on March 15, 2001. However, a careful review of the prosecution history reveals that patentees did not make this request until after the mailing of the notice of allowance, more than four years after the filing of the IDS and after the mailing of many Office actions that did not acknowledge the IDS. As such, this is properly considered a failure to engage within the meaning of 37 CFR 1.704(c)(10). The Office mailed a response on December 30, 2005. Accordingly, the period of reduction is 64 days (beginning on October 28, 2005 and ending on December 30, 2005.)

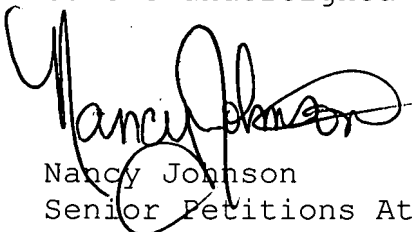
In view thereof, the patent should have issued with a revised patent term adjustment of four hundred eighty-seven (487) days (781 days of Office delay reduced by 294 days of applicant delay).

As this request was submitted to advise the Office of an error in Patentees' favor, the Office will not assess the \$200.00 application fee under 37 CFR 1.705(b). The Office thanks

Patentees for their good faith and candor in bringing this matter to the attention of the Office.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **FOUR HUNDRED EIGHTY-SEVEN (487)** days.

Telephone inquiries specific to this letter should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", is written over the typed name and title.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,084,260 B1

DATED : August 1, 2006

INVENTOR(S) : Lonberg et al.

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (603) days

Delete the phrase "by 603" and insert – by 487 days--